



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/321,882	05/28/99	UPASANI	R 1483.0130002

HM12/0909  
STERNE KESSLER GOLDSTEIN AND FOX PLLC  
SUITE 600  
1100 NEW YORK AVENUE NW  
WASHINGTON DC 20005-3934

EXAMINER  
BADU, B

ART UNIT	PAPER NUMBER
1616	3

DATE MAILED: 09/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/321,882

Applicant(s)

Upasani et al.

Examiner

Barbara Badio

Group Art Unit

1616



☒ Responsive to communication(s) filed on May 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 25-29, 35-43, and 46-57 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1, 2, 25-29, 35-43, and 46-57 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1616

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 25-29 and 46-57, drawn to compounds and compositions, classified in class 552, subclass 500+.
  - II. Claims 1, 2, 25-28 and 46-57, drawn to compounds and composition, classified in class 540, subclass 3+.
  - III. Claim 35, drawn to a method of modulating the GABA<sub>A</sub> receptor-chloride ionophore complex, classified in class 514, subclass 169+.
  - IV. Claim 36, drawn to a method of treating or preventing stress or anxiety, classified in class 514, subclass 169+.
  - V. Claim 37, drawn to a method of alleviating or preventing seizure activity, classified in class 514, subclass 169+.
  - VI. Claims 38-39, drawn to a method of alleviating or preventing sleep related disorders, classified in class 514, subclass 169+.
  - VII. Claim 40, drawn to a method of treating or preventing PMS or PND, classified in class 514, subclass 169+.
  - VII. Claims 41-42, drawn to a method of treating or preventing mood disorders, classified in class 514, subclass 169+.

Art Unit: 1616

VIII. Claim 43, drawn to a method of inducing anesthesia, classified in class 514, subclass 169+.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I(II) and III(IV, V, VI, VII, or VIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using as evidenced by claims 35-43.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is required to elect a single disclosed species from within the elected Group for examination purposes.

Art Unit: 1616

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention and the election of a single disclosed species from within the elected Group to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Telephone Inquiry Contacts***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Barbara Badio  
Art Unit 1616

September 7, 1999